

October 12, 2004
Case No. 7440/4
Serial No.: 09/765,843
Filed: January 19, 2001
Page 6 of 9

REMARKS

Drawings. The Applicant concurrently submits formal drawings in accordance with the Non-Final Office Action.

Claims. In the Non-Final Office Action, Examiner Jackson rejected pending claims 1-10 and 12-17 on various grounds. The Applicant responds to each rejection as subsequently recited herein, and respectfully requests reconsideration of the present application:

- A. Examiner Jackson rejected claims 1-5, 14 and 17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,991,240 to *Van Ryzin* in view of U.S. Patent No. 6,469,239 to *Fukuda*

The Applicant has thoroughly considered Examiner Jackson's remarks concerning the patentability of claims 1-5, 14 and 17 over *Van Ryzin* in view of *Fukuda*. The Applicant has read *Van Ryzin* and *Fukuda* in combination. To warrant this obviousness rejection of claims 1-5, 14 and 17, there must be some suggestion or motivation, either in *Van Ryzin* and/or *Fukuda* or in the knowledge generally available to one of ordinary skill in the art, to modify *Van Ryzin* in view of *Fukuda*. The teaching or suggestion to modify *Van Ryzin* in view of *Fukuda* must be found in the prior art *Van Ryzin* and *Fukuda*, not in the disclosure of the present application. See, MPEP §2143. The Applicant respectfully traverses this obviousness rejection of claims 1-5, 14 and 17, because there is no suggestion or motivation to modify *Van Ryzin* in view of *Fukuda* in view of the fact that *Van Ryzin* teaches away from a digital signal processor "for receiving a first data signal from the external source and for decoding the first data signal to obtain the audio data file" and a programmable controller "for activating an alarm sound coded in the audio data file in response to the programmable controller determining that the alarm sound is required to fulfill one or more programming instructions executed by the programmable controller" as recited in independent claim 1.

October 12, 2004
Case No. 7440/4
Serial No.: 09/765,843
Filed. January 19, 2001
Page 7 of 9

Specifically, *Van Ryzin* discloses a programmable controller 16 for activating an alarm sound coded in a sound circuit 22 in response to the programmable controller 16 determining that the alarm sound is required to fulfill one or more programming instructions executed by the programmable controller 16. *See, Van Ryzin* at column 3, lines 29-42. *Van Ryzin* fails to disclose and teaches away from the alarm sound being coded in an audio data file located in the TV broadcast signal from the TV tuner 12 (i.e., the external source), not memory 20. Moreover, *Van Ryzin* teaches away from the alarm sound being coded in an audio data file located in the TV broadcast signal from the TV tuner 12 by teaching a simple and inexpensive modification of an alarm clock involving a precise listing of holiday music stored in lookup tables of memory 20. As such, modifying *Van Ryzin* in view of *Fukuda* would increase the cost and complexity of DSP 14, microcontroller 16, memory 20 and sound circuit 22 of *Van Ryzin* in violation of the simple and inexpensive concept of *Van Ryzin*. Consequently, one skilled in the art would not have been motivated to modify *Van Ryzin* in view of *Fukuda* as asserted by Examiner Jackson.

Withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over *Van Ryzin* in view of *Fukuda* is therefore respectfully requested.

Claims 2-5, 14 and 17 depend from independent claim 1. Therefore, dependent claims 2-5, 14 and 17 include all of the elements and limitations of independent claim 1. It is therefore respectfully submitted by the Applicant that dependent claims 2-5, 14 and 17 are allowable over *Van Ryzin* in view of *Fukuda* for at least the same reasons as set forth herein with respect to independent claim 1 being allowable over *Van Ryzin* in view of *Fukuda*. Therefore, withdrawal of the rejection of dependent claims 2-5, 14 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Van Ryzin* in view of *Fukuda* is respectfully requested.

October 12, 2004
Case No. 7440/4
Serial No.: 09/765,843
Filed: January 19, 2001
Page 8 of 9

- B. Examiner Jackson rejected claims 6-10, 12, 13, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,991,240 to *Van Ryzin* in view of U.S. Patent 6,469,239 to *Fukuda* and in further view of U.S. Patent No. 5,832,067 to *Herold*

Claims 6-10, 12, 13, 15 and 16 depend from independent claim 1. Therefore, dependent claims 6-10, 12, 13, 15 and 16 include all of the elements and limitations of independent claim 1. It is therefore respectfully submitted by the Applicant that dependent claims 6-10, 12, 13, 15 and 16 are allowable over *Van Ryzin* in view of *Fukuda* and in further view of *Herold* for at least the same reasons as set forth herein with respect to independent claim 1 being allowable over *Van Ryzin* in view of *Fukuda*. Therefore, withdrawal of the rejection of dependent claims 6-10, 12, 13, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Van Ryzin* in view of *Fukuda* and in further view of *Herold* is respectfully requested.

October 12, 2004
Case No. 7440/4
Serial No.: 09/765,843
Filed: January 19, 2001
Page 9 of 9

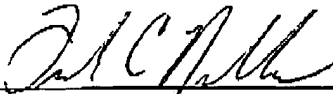
SUMMARY

The Applicant respectfully submits that claims 1-10 and 12-17 as listed herein fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested. If any points remain in issue that may best be resolved through a personal or telephonic interview, Examiner Jackson is respectfully requested to contact the undersigned at the telephone number listed below.

Dated: October 12, 2004

Respectfully submitted,
John J. Emerick, Jr.

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113



Frank C. Nicholas
Registration No. 33,983
Attorney for Applicant